

Hearing:  
July 9, 1998

Paper No. 15  
HRW

THIS DISPOSITION IS NOT CITABLE AS MAY 12, 99  
PRECEDENT OF THE TTAB

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Manufactura de Tabacos (MATASA) S.A.

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Serial No. 75/090,638

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Allen M. Krass of Gifford, Krass, Groh, Sprinkle, Patmore,  
Anderson & Citkowski, P. C. for applicant.

Albert J. Zervas, Trademark Examining Attorney, Law Office  
104 (Sidney Moskowitz, Managing Attorney).

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Before Quinn, Hairston and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Manufactura de Tabacos S.A. has filed an application  
to register the mark PUROS DOMINICANOS for cigars.<sup>1</sup>

Registration has been finally refused on the grounds  
that the mark is primarily geographically descriptive under  
Section 2(e)(2) of the Trademark Act and that the mark is

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<sup>1</sup> Serial No. 75/090,638, filed April 18, 1996, based on a bona  
fide intention to use the mark in commerce.

merely descriptive under Section 2(e)(1) of the Trademark Act.

Applicant and the Examining Attorney have filed briefs and an oral hearing was held.

The Examining Attorney argues that, under the doctrine of foreign equivalents, applicant's mark must be translated to its English equivalent and that the primary translation of PUROS DOMINICANOS would be "Dominican cigars." To support this translation, the Examining Attorney has made of record the following definitions from *Cassells Spanish and English Dictionary*:

Dominicano, -ns. a. Dominican;

puro, -ra a. pure; sheer -n.m. cigar.

As evidence that "Dominican cigars" would be the most likely translation of applicant's mark, rather than treating the term PUROS as an adjective, the Examining Attorney has made of record excerpts from Spanish grammar rules stating that, in Spanish, adjectives agree in gender and number with the nouns they modify; that descriptive adjectives generally follow the noun; and that adjectives denoting nationality always follow the noun.<sup>2</sup> He has also made of record several excerpts from the NEXIS database in

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<sup>2</sup> A. Jarvis et al, *Como se dice...?* (1994).

which the word "puros" is shown to have been recognized in English publications as the Spanish term for "cigars", and thus would be translated as such. The following are representative:

Cigar aficionados take note: many brands of premium, hand-rolled "puros" may become even harder to come by as the holidays approach. *Austin American-Statesman* (October 23, 1996);

But the purros, as the cigars are called in Spanish, are not what they once were. *Chicago Tribune* (December 2, 1995).

With applicant's mark being translated as "Dominican cigars," the Examining Attorney maintains that the mark is both geographically descriptive of applicant's goods, i.e., cigars which come from the Dominican Republic,<sup>3</sup> and merely descriptive, in that it describes the cigars as being made of Dominican tobacco.

Applicant, on the other hand, argues that the mark should not be translated in the first place, since this is a mark which is not likely to be translated by consumers, but rather should be preserved in the Spanish words. If it were translated, applicant argues that the most likely meaning that would be attached to the term PUROS would be "pure" and thus DOMINICANOS would be viewed as a plural

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<sup>3</sup> Applicant's address in the application is in the Dominican Republic.

noun meaning "Dominican ones" or "Dominicans." As such, applicant argues that the mark is neither descriptive nor geographically descriptive. Instead, applicant contends, the mark should be given an interpretation comparable to that given to ALL-AMERICAN in *Wilco Co. v. Automatic Radio Manufacturing Co., Inc.*, 151 USPQ 24 (D. Mass 1966), or to GREAT AMERICAN in *In re Jim Crockett Promotions, Inc.*, 5 USPQ2d 1455 (TTAB 1987), as more than a description of the origin or other characteristics of applicant's goods. Applicant argues the mark should be viewed as suggestive of the "level of pure, unadulterated high Dominican quality" of applicant's cigars. (Brief p. 4).

In response to applicant's proffered translation of the mark as "Pure Dominicans,"<sup>4</sup> the Examining Attorney argues that the mark remains unregistrable under Section 2(e)(1). He maintains that, even with the translation "Pure Dominican," the mark merely describes a feature of applicant's goods, i.e., that the cigars contains pure or only Dominican tobacco. He argues that this is not a situation similar to the *Wilco* case, in that "Pure

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<sup>4</sup> We agree with the Examining Attorney that applicant has submitted no evidence that DOMINICANOS would be translated as "Dominican ones" and thus such a translation has not been considered.

Dominican" means just that and has no additional connotation.<sup>5</sup>

It is well settled that normally no distinctions can be made between English terms and their foreign equivalents for purposes of registrability, and the foreign equivalent of a merely descriptive or geographically descriptive English term is no more registrable than the English term, even though the foreign term may not be commonly known to members of the general public in the United States. See *In re Atavio Inc.*, 25 USPQ2d 1360 (TTAB 1992); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983) and the cases cited therein. Exceptions to this rule have been made in a few cases, where the foreign expression was one which even those familiar with the language would not translate or where it was unlikely that purchasers would translate the foreign expression as it was encountered on the goods. In *re Jos. Schlitz*, *supra*.

Here we are thoroughly convinced that the mark is one which persons familiar with the Spanish language would translate and also is one which purchasers of cigars,

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<sup>5</sup> While, as pointed out by applicant, the Examining Attorney has referred to the translation as "Pure Dominican" rather than "Pure Dominicans," we cannot agree with applicant that this discrepancy affects the connotation of the translation.

regardless of their familiarity with Spanish, would translate. In the first place, knowledge of Spanish is prevalent in the United States and the mark is easily translated. Second, and even more importantly, as shown by the NEXIS evidence submitted by the Examining Attorney, the word "puros" is one which would be likely to be recognized by cigar aficionados, regardless of their overall knowledge of Spanish, as the Spanish term for "cigars."

Contrary to applicant's arguments, we do not find applicant's use of the mark PUROS DOMINICANOS, in connection with cigars, to be in any way comparable to the circumstances in *In re Pan Tex Hotel Corp.*, 190 USPQ 109 (TTAB 1976). There the Board found it unlikely that consumers of the lodging and restaurant services offered under the mark LA POSADA would stop and translate the mark into its English equivalent, "the inn," when consideration was given to the manner of use of the mark and the nature of the services with which it was being used. Here applicant specifically intends to use PUROS DOMINICANOS in connection with cigars originating from the Dominican Republic, making translation virtually inevitable. See *In re Jos. Schlitz Brewing Co*, *supra* [argument that the mark KUHLEBRAU, as used for beer, is one which purchasers would not be likely to translate is not persuasive].

We also find that "Dominican cigars" would be the most likely and reasonable translation for applicant's mark PUROS DOMINICANOS. The dictionary definitions, the rules of Spanish grammar and the NEXIS evidence all point us to this conclusion. While "Pure Dominicans" might be a potential stab at translation for persons not familiar with Spanish, we cannot accept this meaning as the most likely, or appropriate, one.

Accordingly, we turn to the refusals at hand on the basis that applicant's mark is the foreign equivalent of "Dominican cigars" and that it is intended for use with cigars.

In order for registration to be refused under Section 2(e)(2) of the Trademark Act, on the ground that the mark is primarily geographically descriptive of the goods or services, it must be established that

- (1) the mark sought to be registered is the name of a place known generally to the public, and
- (2) the public would make a goods/place (or in this case, services/place) association, i.e., would believe that the services originate from this place.

See *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988).

Where there is no question but that the geographic significance of a term is its primary significance, and the place named is neither obscure nor remote, a public association of the goods (or services) with the place may be presumed if, in fact, the goods (or services) originate from the geographic place named in the mark. See *In re California Pizza Kitchen Inc.*, *supra*; *In re Handler Fenton Westerns, Inc.* 214 USPQ 848 (TTAB 1982). Moreover, the addition of highly descriptive or generic matter to a geographic term does not detract from the mark's primary significance as being geographically descriptive. See *In re U.S. Cargo Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986).

Here the term "Dominican" clearly refers to the geographic location the Dominican Republic. Not only may the association of cigars with this location be presumed, but the Examining Attorney has also introduced specific evidence that tobacco is a chief product of the Dominican Republic.<sup>6</sup> The addition of the generic term "cigars" does not detract from the geographic significance of the mark. Applicant's mark PUROS DOMINICANOS is primarily

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<sup>6</sup> *Webster's New Geographical Dictionary* (1988).



geographically descriptive of the goods upon which it is intended to be used.

In view of our holding under Section 2(e)(2), we find it neither necessary nor appropriate to consider the further refusal of applicant's mark, when translated as "Dominican cigars," as merely descriptive under Section 2(e)(1). We have found the primary significance of the mark to be one of geographic descriptiveness.

Furthermore, even if we adopt the translation proffered by applicant, namely, "Pure Dominicans," we consider applicant's mark to be primarily geographically descriptive. While we agree with the Examining Attorney that "Pure Dominicans" would be viewed as a description of the ingredients of the cigars, i.e., that they are made of pure Dominican tobacco, we find this to still be a combination of the name of the geographic location from which applicant's cigars (and the tobacco from which they are made) originate and a highly descriptive term. Cf. *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983)[since tobacco and cigars are important products from the Bahia region, purchasers of cigars bearing mark BAHIA would believe they originated in Bahia]. The refusal under Section 2(e)(2) stands.

Applicant's arguments that "pure Dominican" rises to the level of suggestiveness are not persuasive, in the absence of any evidence of an additional recognized significance for the phrase. The mark cannot be equated with the phrase "All-American." In fact, even if the mark indicates a "level of pure, unadulterated high Dominican quality," as argued by applicant, it would still be primarily geographically descriptive of the cigars upon which it is intended to be used.

Decision: The refusal to register under Section 2(e)(2) is affirmed.

T. J. Quinn

P. T. Hairston

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board